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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of : **Confirmation No. 4977**  
Peter HEROLD et al. : Attorney Docket No. 2006\_0980A  
Serial No. 10/587,150 : Group Art Unit 1625  
Filed July 24, 2006 : Examiner John Mabry  
  
AMINO ALCOHOL DERIVATIVES AND  
THEIR ACTIVITY AS RENIN INHIBITORS : **Mail Stop: Amendment**

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**RESPONSE TO RESTRICTION REQUIREMENT**  
**AND**  
**REQUIREMENT FOR ELECTION OF SPECIES**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

THE COMMISSIONER IS AUTHORIZED  
TO CHARGE ANY DEFICIENCY IN THE  
FEE FOR THIS PAPER TO DEPOSIT  
ACCOUNT NO. 23-0975.

Sir:

This is responsive to the Office Action of March 21, 2008.

Initially, though the Office Action Summary page indicates that claims 1-7 and 10-13 are pending in the application, the pending claims are claims 1-13. These claims are set forth in the Preliminary Amendment filed with the application papers on July 24, 2006.

**Substance of Interview**

On April 7, 2008, Applicants' attorney contacted the Examiner by telephone, and noted that the definitions for the Group I and II subject matter in the Office Action does not reflect the claims, because the claims do not encompass compounds where X<sub>1</sub> is amino, as indicated in Groups I and II. Rather, the claims reflect that X<sub>1</sub> is carbonyl or methylene. After considering this matter, the Examiner informed Applicants' attorney that Groups I and II should define X<sub>1</sub> as methylene rather than amino.

## Election

With this correction in place, Applicants hereby elect the subject matter of Group I.

The Examiner has also required a further election of a single disclosed species, in response to which Applicants elect the compound of Example 1 on page 21 of the specification. All of claims 1-13 read on the elected species.

### **These elections are made with traverse.**

Traversal is based on the fact that, contrary to the opinion of the Examiner, the instant claims do not encompass compounds of formula I of EP 0519433. In formula I of this reference, the COH-group and the NH-group are separated by just one carbon atom (the CHR<sup>4</sup>-group), whereas the instant formula (I) shows four carbon atoms, including the group X<sub>1</sub> which can be carbonyl or methylene. It is improper to base a restriction requirement on this erroneous interpretation of the chemical formulae. Applicants thus respectfully submit that **the special technical features** of the present invention and the EP '433 reference **are different from each other**.

For these reasons, Applicants take the position that the requirement for restriction and election of species is improper and should be withdrawn.

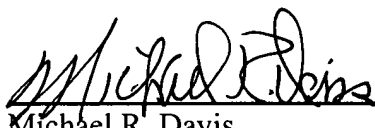
Applicants note that the foregoing elections are made while reserving their rights under 35 U.S.C. §121 to file a divisional application for the non-elected subject matter, although as indicated above, Applicants have traversed the restriction requirement and requirement for election of species.

Action on the merits is requested.

Respectfully submitted,

Peter HEROLD et al.

By:

  
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Michael R. Davis  
Registration No. 25,134  
Attorney for Applicants

MRD/pth  
Washington, D.C. 20006-1021  
Telephone (202) 721-8200  
Facsimile (202) 721-8250  
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